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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,400	03/31/2004	Benjamin N. Eldridge	P71C2-US	7966
50/905 7590 09/14/2009 N. KENNETH BURRASTON KIRTON & MCCONKIE P.O. BOX 45120 SALT LAKE CITY, UT 84145-0120				
EXAMINER				
KARLSEN, ERNEST F				
ART UNIT		PAPER NUMBER		
2829				
NOTIFICATION DATE		DELIVERY MODE		
09/14/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/815,400

Applicant(s)

ELDRIDGE ET AL.

Examiner

ERNEST F. KARLSEN

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47, 49, 53-55, 60-63, 67 and 70-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47, 49, 53-55, 60-63, 67 and 70-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 01/28/2009 06/01/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The declaration under 37 CFR 1.132 filed June 1, 2009 is insufficient to overcome the rejection of claims 47, 49, 53-55, 60-63, 67 and 70-78 based upon any rejection as set forth in the last Office action because: The magnification used to produce the pictures is not specified. Aluminum pads quickly become covered with oxide when exposed to air but the pads of the declaration appear from the text to not be aluminum. Whatever they are they may not produce oxide. The pictures are of such poor quality that it is impossible to determine what they represent.

Claims 47, 49, 53-55, 60-63, 67 and 70-80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what the structural result would be for the semiconductor die that is tested by any of the claims. No structural features are disclosed in the specification and no structural features are presented by the claims. What structural effects would result from the process steps of claims 60-63, 67 and 70-80 is not clear. How such would lead to a functional change is not clear. The limitations of claims 47, 49 and 53-55 seem to be yet further away from having any influence on a functional change. What influence does the material composition of the blade have on the structure produced. No description of what the structure would look like for any of the claims is presented in the disclosure. It is still not clear what the structural result would be for the semiconductor die that is tested by the process of any of the claims. Any structural result appears to be akin to placement of an identifying mark which appears to be a kind of printing. Thus what Applicants are claiming is an old device with some kind of printing thereon. Again

no illustration of the structure is present in the specification or drawings so it is not clear what the product would be. It is still not clear what is meant by "cutting edge" and "slice mark".

Applicants take issue with Examiner's statements of lack of understanding but the Examiner considers the words used were not present in the original disclosure and are being used to define an indeterminate process.

Claims 47, 49, 53-55, 60-63, 67 and 70-80 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear what is meant by "cutting edge" or "slice mark". The quoted terms do not appear in the original disclosure and are considered new matter. There is no original disclosure that blades are "pressed" against pads. It is not clear what "pressed" means.

The words objected to the words used were not present in the original disclosure and are being used to define an indeterminate process. Figures 2A and 2C do not show what is being claimed. No showing of a mark in a pad is shown.

Claims 47, 49, 53-55, 60-63, 67 and 70-80 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to

make and/or use the invention. It is not clear how Applicants' blade can "slice", "slice cleanly", "cut" or "cut cleanly". Such terms appear in the abstract and pages 5, 10 and 11 of the specification. Aluminum oxide is a ceramic material and has a crystalline structure. The Examiner is not aware that a brick of aluminum oxide can be sliced or cut with a knife. A knife could no doubt be used to saw through an aluminum oxide layer because a real world knife edge is rough. Such sawing would leave a pile of aluminum oxide dust and presumably the cut or slice could not be considered "cleanly". Any cut through a sheet of aluminum oxide will leave dust or chunks. Some non-crystalline materials such as plastic or butter seem to slice reasonably cleanly. It is not clear from Applicants' disclosure how aluminum oxide can be "sliced cleanly" or "cut cleanly". Applicants' make argument, in previous responses to office actions that, in effect, say that "sliced" means "sliced cleanly" and not "break", "smash", "split", "divided into parts violently" or "reduce to pieces or fragments". Given such meaning to "sliced" it is not clear from Applicants' disclosure how "sliced" can be accomplished without "break", "smash", "split", "divided into parts violently" or "reduce to pieces or fragments". The Examiner does not understand how anything can be sliced cleanly.

The Examiner remains of the opinion that nothing can "sliced cleanly". The quality to the pictures of the declaration of June 1, 2009 are not of sufficient quality or magnification to show "sliced cleanly".

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the semiconductor

product must be shown or the feature(s) canceled from the claim(s). Note that Figures 2A and 2C do not show final structure of the pad. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application

filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 47, 49, 60-63, 67, 70, 72-75 and 78-80 are rejected under 35 U.S.C. 102(e) as being anticipated by Kennedy. With regard to claims 47, 49, 60-63, 67, 70, 72-75 and 78, Kennedy shows, in Figure 6, a chip 13 with pads "pressed" against a probe in the form of a blade 71, see column 7, lines 63-67. The blade 71 inherently has a "cutting edge" along the part of the blade 71 that contacts the pad. Because the blade 71 is at the end of a cantilever arm 37a it will inherently deflect across the terminal. The blade 71 as shown in Figures 5-8 of Kennedy will inherently deflect in a motion that is approximately parallel to the length of the blade which is within plus or minus 45 degrees. The "cutting edge" of the blade inherently has to penetrate the surface to make contact. The limitations of claims 79 and 80 are considered inherent in the apparatus of Kennedy.

Applicants have argued in their response that the blade of Kennedy has only vertical motion with no lateral motion. The free end of a cantilevered beam will always move in an arc when deflected. Thus the blade of Kennedy will inherently deflect across the terminals when the free end of the cantilevered beam of Kennedy moves relative to the end that does not move. The deflection will be parallel to the axis and thus within all angular ranges claimed. The blade of Kennedy will inherently have a slope adjacent its contact edge. Applicants present argument as if their blade has a non-curved edge such as a straight edge. A straight edge may be shown in the drawings but is not claimed.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 53-55, 71, 76 and 77 rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy. With regard to claims 53-55, 71, 76 and 77, there is no disclosure of criticality of the composition or shape of the interconnection element or the tip. Because of no indication of criticality such features are considered obvious.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernest F. Karlsen whose telephone number is 571-272-1961. The examiner can normally be reached on 8 hrs. Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ha Nguyen can be reached on 571-272-1678. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ernest F. Karlsen/
Primary Examiner, Art Unit 2829